

Please Direct All Correspondence to Customer Number **20995**



TRANSMITTAL LETTER

Applicant : Girard, et al.
App. No : 10/601,072
Filed : June 19, 2003
For : CHEMOKINE-BINDING PROTEIN AND
METHOD OF USE
Examiner : Unassigned
Art Unit : 1641

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

June 28, 2005

(Date)

[Signature]
Jerry L. Hefner, Reg. No. 53,009

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
JUL 06 2005
OFFICE OF PETITIONS

Dear Sir:

Enclosed for filing in the above-identified application are:

- (X) Request for Reconsideration of Petition under 37 C.F.R. §1.183.
- (X) Copy of Petition from Application No. 10/317,832.
- (X) Copy of Decision Granting Petition from Application No. 10/317,832.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.
- (X) Return prepaid postcard.

[Signature]
Jerry L. Hefner
Registration No. 53,009
Attorney of Record
Customer No. 20,995
(619) 235-8550

1793133:dmb
062805

RECEIVED
OIPE/IAP

JUL 14 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT RECEIVED
JUL 06 2005
OFFICE OF PETITIONS

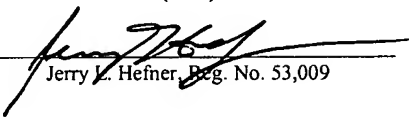
Applicants : Girard et al.
Appl. No. : 10/601,072
Filed : June 19, 2003
For : CHEMOKINE-BINDING
PROTEIN AND METHODS
OF USE
Examiner : Not Yet Assigned
Art Unit : 1641

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

June 28, 2005

(Date)


Jerry L. Hefner, Reg. No. 53,009REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. §1.183

Mail Stop Petition
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the petition dismissal mailed by the Office of Petitions on April 29, 2005. In response to the decision, Applicants hereby submit a request for reconsideration of the petition.

In the Petition filed March 14, 2005, the Applicants noted that an IDS was being submitted, along with copies of several listed references. One of the references being submitted was PCT Publication Number WO 01/57190, which contains a Sequence Listing that is greater than 5,000 pages in length. Because of the large size of the sequence listing, Applicants requested that submission of a paper copy of the sequence listing portion of the particular reference be waived. Applicants further noted that the USPTO already possesses an electronic copy of the particular sequence listing in its databases, since the sequence listing is from a PCT

Appl. No. : **10/601,072**
Filed : **June 19, 2003**

application that was filed in the United States and because such possession had been acknowledged by the USPTO in their grant of identical petitions filed in connection with the same reference in related patent applications.

The Office of Petitions dismissed the instant petition, stating that Applicants did not state the specific provision of the rules for which a waiver is requested. Furthermore, the Office of Petitions asserted that Applicants did not describe why justice requires the suspension of the rule. Subsequent to the dismissal of this petition, Applicants' representative contacted the Petitions Examiner to discuss reconsideration of the dismissal. As discussed with the Petitions Examiner, Applicants hereby provide the specific provision of the rule for which waiver is required and an explanation of why justice requires waiver of this rule.

In this request for reconsideration of the Petition filed on March 14, 2005, the disclosure of which is incorporated herein by reference, Applicants set forth the following:

Applicants respectfully request that the patent rule requiring the submission of a legible copy of a publication listed in an IDS, 37 CFR 1.98(2)(ii), be waived in reference to PCT Publication Number WO 01/57190.

37 CFR 1.98(2)(ii); states that:

"any information disclosure statement filed under § 1.97 shall include:

(2): a legible copy of:

(ii): Each publication or that portion which caused it to be listed."

Justice requires the suspension of the rules in the instant situation in view of the excessive burden that is created for both the Applicants and the USPTO in connection with the submission of a paper copy of an approximately 5,000 page sequence listing. This amount of paper would be extremely burdensome both for the Applicants to prepare and for processing at the PTO. Moreover, it is unlikely that a paper copy of a sequence listing of that size would possess any useful value. Practically speaking, it is unlikely that the Examiner would leaf through a 5,000 page document and attempt to identify like sequences without the aid of a computer. In fact, as noted above, the PTO has an electronic copy of the sequence listing from this application in its database and Examiners typically utilize the PTO's sequence database to assess the pertinence of the sequences therein with respect to a pending patent application. As

Appl. No. : 10/601,072
Filed : June 19, 2003

such, the burden of submitting such a large paper copy of the sequence listing far outweighs the value, if any, of having a paper copy of the document associated with the file.

Furthermore, please note that an identical petition requesting waiver of 37 C.F.R. § 1.98(2)(ii) was granted in the parent case, U.S. Patent Application Serial No. 10/317,832. A copy of the petition and the decision granting the position are submitted herewith for your convenience.

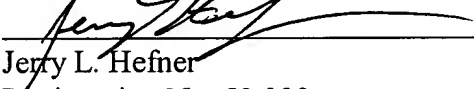
Please feel free to contact the undersigned if you have any questions regarding this request for reconsideration of the Petition.

It is presumed that no fee is required for the submission of this response to the Petition Decision. However, if fees are required, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 28, 2005

By: 
Jerry L. Hefner
Registration No. 53,009
Attorney of Record
Customer No. 20,995
(619) 235-8550

1777260
061705



BIOBANK.009A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Girard et al.)	Group Art Unit 1653
)	
Appl. No.	:	10/317,832)	
)	
Filed	:	December 10, 2002)	
)	
For	:	NOVEL DEATH ASSOCIATED PROTEINS, AND THAP1 AND PAR4 PATHWAYS IN APOPTOSIS CONTROL)	
)	
Examiner	:	Unknown)	

RECEIVED
JUL 10
OFFICE OF PETITION

PETITION UNDER 37 C.F.R. §1.183

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On August 6, 2003, in connection with the above-identified patent application, Applicants filed with the USPTO an Information Disclosure Statement, Form PTO-1449 listing 11 references, and copies of the listed references. Copies of the Information Disclosure Statement and Form PTO-1449 are provided herewith.

Among the references listed on Form PTO-1449 is PCT Publication Number WO 00/58473 and PCT Publication Number WO 01/57190, each of which contains a Sequence Listing that is greater than 5000 pages in length. It is Applicants' understanding that the USPTO has a copy of each of these Sequence Listings in its electronic database. Accordingly, Applicants respectfully request that the requirement for submitting a paper copy of the Sequence Listing be waived and that Applicants be permitted to submit only a paper copy of the specification from PCT Publication Numbers WO 00/58473 and WO 01/57190 with the Information Disclosure Statement in the above-identified application and any application claiming priority thereto.

Appl. No. : 10/317,832
Filed : December 10, 2002

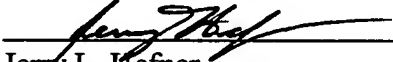
Please feel free to contact the undersigned if you have any questions regarding this Petition.

Applicants have provided the fee required by 37 C.F.R. §1.17(h) herewith. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

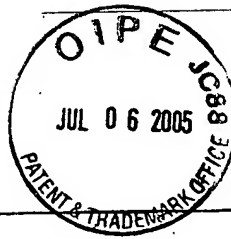
Dated: August 15, 2003

By: 
Jerry L. Hefner
Registration No. 53,009
Attorney of Record
Customer No. 20,995
(619) 235-8550

S:\DOCS\JLHV\H-2173.DOC:081503



UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

KNOBBE MARTENS OLSON & NEAR LP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

COPY MAILED

NOV 25 2003

OFFICE OF PETITIONS

In re Application of
Girard et al.
Application No. 10/317,832
Filed: December 12, 2002
Attorney Docket No. BIOBANK.009A

:
:
: DECISION GRANTING PETITION
: UNDER 37 CFR 1.183
:

This is a decision on the petition under 37 CFR 1.183 filed August 18, 2003, which is being treated as a petition to waive the requirements of 37 CFR 1.98.

The petition is **granted in part**.

Petitioners seek waiver of the requirement to supply a complete copy of two references cited in the IDS filed August 6 (sic, 14) 2003; PCT publication Nos. WO 00/58473 and WO 01/57190. Petitioners assert that each document contains a sequence listing greater than some 5000 pages each, and further, as petitioners believe that the USPTO has a copy of each listing in its electronic database, it would constitute an undue burden on both petitioners and the USPTO to process the complete paper files..

Based on inspection of the WIPO database, WO 00/58743 corresponds to PCT /US00/08621, and WO 01/57190 corresponds to PCT/US01/04098. Unfortunately for petitioners, as neither the former document nor its corresponding PCT application appear to have an entry in the USPTO ABSS electronic database, the requested relief is **dismissed** as to WO 00/58743, which corresponds to PCT/US/08621.

However, the petition is **granted** with respect to WO 01/57190, which corresponds to PCT/US01/04098, as the sequence listing of the latter document has been entered in the USPTO electronic database.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-1820.


Brian Hearn

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy